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19 Defendant, and Counterclaimant
20 RSA Data Security, Inc.

21
22 UNITED STATES DISTRICT COURT
23 NORTHERN DISTRICT OF CALIFORNIA

24 RSA DATA SECURITY, INC., a
25 Delaware corporation,

26 Case No. C96-20094-SW (PVT)

27 Plaintiff,

28 PLAINTIFF'S MEMORANDUM OF
POINTS AND AUTHORITIES IN
OPPOSITION TO DEFENDANTS'
MOTION IN LIMINE TO EXCLUDE
TESTIMONY OF TECHNICAL EXPERTS

v.

The Hon. Spencer Williams

29 CYLINK CORPORATION, a
30 California corporation, CARO-
31 KANN CORPORATION, a California
32 Corporation, and THE BOARD OF
33 TRUSTEES OF THE LELAND
34 STANFORD JUNIOR UNIVERSITY, a
35 California corporation,

36 Defendants.

37 AND RELATED COUNTERCLAIMS.

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46 PLAINTIFF'S OPPOSITION MOTION TO
47 EXCLUDE TESTIMONY OF TECHNICAL
48 EXPERTS; C96-20094-SW

1 I. INTRODUCTION

2 There is no basis for Defendants' motion to preclude
 3 technical experts from testifying at the Markman hearing.^{1/}
 4 The motion is meritless and premature and should be denied.

5 As the Court anticipated when it set a discovery track
 6 for Markman expert depositions, plaintiff RSA Data Security, Inc.
 7 ("RSA") has designated technical experts to testify at the claim
 8 construction hearing. Defendants chose not to designate any
 9 experts, however, and now seek to exclude or limit the testimony
 10 of RSA's experts.

11 Defendants' entire motion rests on the erroneous
 12 assumption that expert testimony is suspect evidence to be
 13 admitted and considered only in rare circumstances. The law is
 14 contrary to Defendants' assumption. Markman itself, as well as
 15 numerous subsequent decisions by the Federal Circuit, confirm
 16 that a district court considering the meaning of disputed patent
 17 terms may admit and rely on expert testimony.

18 To the extent that Defendants' motion seeks to have the
 19 Court draw a distinction between expert testimony concerning the
 20 meaning of patent terms and expert testimony concerning ultimate
 21 legal issues of claim construction, the motion is premature. It
 22 is pointless for Defendants to attempt to excise certain opinions
 23 from the anticipated testimony of RSA's experts before those
 24 experts even take the stand at the Markham hearing. The Court,

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 27 1/ Defendants Cylink Corporation, Caro-Kann Corporation and
 28 Stanford University (collectively "Defendants" or "Cylink")
 filed the Expedited Motion in Limine to Exclude Technical
 Expert Testimony ("Defendants' Expert Motion").

1 not Defendants, must determine which expert testimony is helpful
 2 and which expert testimony is not. At the Markman hearing the
 3 Court will have an opportunity to evaluate the testimony of RSA's
 4 experts and Defendants will have an opportunity to object to any
 5 particular questions which they deem to call for impermissible
 6 legal opinion.

7 II. ARGUMENT

8 A. The Testimony Of Technical Experts Is Admissible.

9 It is well settled that extrinsic evidence, including
 10 expert testimony, is admissible "to aid the court in coming to a
 11 correct conclusion' as to the 'true meaning of the language
 12 employed' in [a] patent." Markman v. Westview Instruments, Inc.,
 13 52 F.3d 967, 980 (Fed. Cir. 1995), aff'd 517 U.S. ___, 134
 14 L.Ed.2d 577, 116 S.Ct. 562 (1996) (quoting Seymour v. Osborne, 78
 15 U.S. (11 Wall) 516, 546 (1871)). Indeed, Defendants concede that
 16 "testimony from technical experts concerning the factual matter
 17 of how terms are used in the art" is admissible. Defendants'
 18 Expert Motion at 3:20-23. Despite this concession, Defendants
 19 attempt to argue that expert testimony is disfavored evidence
 20 which courts should be reluctant to admit or consider. Id. at
 21 3:26 - 4:13. (citing Vitronics Corporation v. Conceptronic, Inc.,
 22 90 F.3d 1576 (Fed. Cir. 1996)). Defendants' argument must
 23 fail.

24 First, Vitronics is only a panel decision, it cannot
 25 overrule the numerous other recent decisions of the Federal
 26 Circuit concerning extrinsic evidence. In the wake of Markman
 27 the Federal Circuit repeatedly has confirmed that expert
 28

1 testimony is important evidence which properly may be admitted
 2 and considered by courts construing patent claims. See e.g.
 3 National Presto Industries, Inc. v. West Bend Company, 76 F.3d
 4 1185, 1190 (Fed. Cir. 1996) (district court properly admitted
 5 expert testimony regarding the meaning of various disputed claim
 6 terms used in a patent for a vegetable cutter); Pall Corporation
 7 v. Micron Separations, 66 F.3d 1211 (Fed. Cir. 1995) (testimony
 8 of technical expert properly admitted). Indeed, the Federal
 9 Circuit itself has been "greatly aided in understanding. . . terms
 10 in the context in which they are used by consideration of the
 11 testimony of. . . expert witnesses." National Presto, 76 F.3d at
 12 1190. See also Hoechst Celanese Corporation v. BP Chemical
 13 Limited, 78 F.3d 1575, 1579 (Fed.Cir. 1996) (Federal Circuit
 14 relies on "the testimony of experts in the field" regarding "the
 15 scientific meanings of stable and dimension as applied to
 16 macroreticulated cation-exchange resins in organic medium.")

17 Second, Vitronics itself does not sweep as broadly as
 18 Defendants contend. Contrary to Defendants' assertions,
 19 Vitronics does not direct courts to exclude expert testimony.
 20 Rather, the case expressly notes that a trial court is entitled
 21 to hear all extrinsic evidence, including expert testimony,
 22 before construing the claims at issue. Id. at 1584 - 85 (holding
 23 that the trial court did not err in admitting expert testimony,
 24 but erred in using extrinsic evidence to contradict the manifest
 25 meaning of the claims).^{2/}

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 28 2/ Defendants are also wrong in suggesting that Vitronics stand
 for the proposition that "inventor testimony" carries more
 (continued...)

1 In light of the Federal Circuit's numerous post-Markman
2 decisions holding that the testimony of technical experts is
3 admissible in construing the terms of a patent, Defendants cannot
4 credibly argue that such testimony should be presented in a
5 tutorial format and treated as "factual background" rather than
6 as "admissible objective evidence." Defendants' Expert Motion at
7 4:26-5:2. Expert testimony is admissible evidence and should be
8 part of the record.

9 As the court noted in Markman: "When, after
10 considering the extrinsic evidence, the court finally arrives at
11 an understanding of the language as used in the patent and
12 prosecution history, the court must then pronounce as a matter of
13 law the meaning of that language." Markman, 52 F.3d at 981. In
14 setting down its findings regarding the meaning of patent
15 language, this Court will need to be able to cite to the evidence
16 supporting its conclusions. See National Presto, 76 F.3d at 1190
17 (district court properly relied on expert witness testimony
18 admitted as evidence in determining meaning of patent terms).
19 Limiting expert testimony to the tutorial would leave the record
20 incomplete and would essentially preclude this Court from
21 referring to any expert testimony in support of its rulings.
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24 2/(...continued)

25 "evidentiary weight" than expert testimony. Defendants'
26 Expert Motion at 4:8-12. Vitronics actually holds that "the
27 inventor's subjective intent as to claims scope, when
28 unexpressed in the patent documents" cannot have any effect.
Vitronics, 90 F.3d at 1584. In order for an inventor's
testimony to carry any weight, the inventor must be
testifying as "an expert in the field." Hoechst Celanese
Corporation v. B.P. Chemicals Limited, 78 F.3d at 1580.

1 B. Defendants' Motion Is Unworkable And Premature.

2 Ultimately, Defendants' motion must fail because the
 3 relief requested makes no sense. Notwithstanding their attempt
 4 to confine all expert testimony to the tutorial, Defendants
 5 acknowledge that RSA will be entitled to present expert testimony
 6 in the context of the Markman hearing. Defendants then ask the
 7 Court to "scrutinize" this testimony, exclude any testimony going
 8 to the ultimate legal issue of the proper construction of the
 9 claims, and carefully consider the weight to be given to
 10 testimony concerning the interpretation of particular terms. See
 11 Defendants' Expert Motion at 5:2-18.

12 Until RSA's experts take the stand, there is no
 13 testimony for the Court to scrutinize or weigh. Similarly, until
 14 RSA's witnesses have begun testifying it is inefficient, if not
 15 impossible, to attempt to draw a line distinguishing "term
 16 interpretation" testimony from "claim construction" testimony.

17 Debating the proper scope of expert testimony at this
 18 time will result in an unnecessary side show. RSA anticipates
 19 that its experts will testify for no more than a few hours each
 20 at the Markman hearing. At the hearing, Defendants will have an
 21 opportunity to object to any questions which they perceive as
 22 calling for improper or inadmissible answers. The Court will
 23 then be able to evaluate specific objections in context. The
 24 Court will also be able to consider all expert testimony and give
 25 to each portion of that testimony the weight which the Court
 26 deems appropriate.

1 III. CONCLUSION

2 For the foregoing reasons, this Court should deny
3 Defendants' motion to exclude or limit the testimony of RSA's
4 experts at the Markman hearing. Under Markman and its progeny,
5 testimony of technical experts is admissible extrinsic evidence.
6 To the extent that Defendants are concerned that RSA's experts
7 may seek to give opinions on matters not properly within the
8 scope of expert testimony, the Court can most efficiently address
9 such concerns by considering timely objections at the Markman
hearing.

10 Dated: 9/24, 1996

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